

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No.: 10/671,556

Attorney Docket No.: Q77374

**AMENDMENTS TO THE DRAWINGS**

Figure 1 is attached and properly labeled as "Replacement Sheet".

Attachment: Figure 1 Replacement Sheet

**REMARKS**

Claims 1-3 and 5-13 have been examined, and have been rejected under 35 U.S.C. § 112, second paragraph, as well as 35 U.S.C. § 103(a). Claims 1, 8-13 have been amended to include the subject matter of claims 2 and 6. Claims 2 and 6 have consequently been canceled without prejudice or disclaimer.

**I. Preliminary Matters**

The Examiner has not acknowledged the claim for foreign priority. Accordingly, Applicant requests that the Examiner acknowledge the claim for foreign priority, in the next Office Action, by checking the appropriate boxes on the Office Action Summary.

Also, the Examiner has indicated that the proposed corrections of Fig. 1 are acceptable. However, the Examiner has required that Applicant resubmit the sheet with the label "replacement sheet." A replacement sheet is submitted herewith as indicated above. Consequently, Applicant requests that the Examiner approve the drawings.

**II. Rejections under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claims 1, 8, 9 and 10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Examiner has requested clarification as to how the paper returner is placed at the first and second positions (i.e., how it pivots). However, it appears that the Examiner is equating breadth with indefiniteness. The fact that a claim is broad, does not necessitate a rejection for indefiniteness reasons (see MPEP §2173.04). In non-chemical arts, a claim may generally be written as broadly as permitted by the prior art.

Claims 1, 8, 9 and 10 currently recite that the paper returner is pivotable between a first and second position. Applicant submits that such recitation is clear, and that no further structure

needs to be recited since the addition of further structure would unduly narrow the scope of the claims. In particular, the specific details of “how” the paper returner pivots between the two positions, whether manually or otherwise, is not necessary to the claims.

In view of the above, Applicant submits that the metes and bounds of the claim are well defined. For example, if an accused device has a paper returner which pivots between the positions as claimed, then it falls within the scope of the recitation. On the other hand, if a paper returner of the accused device does not pivot between the respective positions as claimed, then it falls outside the scope of the recitations. Thus, the claimed recitations clearly satisfy the requirements of 35 U.S.C. § 112, second paragraph, and further amending the claims, to recite additional structure, would unduly narrow the scope of the claim.

Also, the Examiner maintains that the above language of the claims is “functional.” Applicant submits that it is not improper to define structure in terms of functional limitations. Functional limitations define things by what they do, rather than by what they are. As stated in MPEP § 2173.05(g), functional language does not, in and of itself, render a claim improper, and a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. The language used to define the specific positions of the paper returner sets definite boundaries on the patent protection sought, MPEP § 2173.05(g).

Claims 5 and 6 have also been rejected under 35 U.S.C. § 112, second paragraph. Claim 5 has been amended as indicated above and claim 6 has been cancelled without prejudice or disclaimer. The “widthwise” direction clarifies which direction of the paper is being discussed, and as such is not indefinite. Further, in regard to the Examiner’s comments that the widthwise

direction extends across the sheet of paper and *beyond*, Applicant submits that the claim specifically recites that the widthwise direction is in regard to the sheet of paper, and thus is confined to the width of the paper alone, and not arbitrary space beyond the paper.

### **III. Rejections under 35 U.S.C. § 103(a)**

Claims 1-3 and 5-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 55-044473 to Hashida (“Hashida”) in view of U.S. Patent No. 6,199,855 to Choeng (“Choeng”) (both cited in Information Disclosure Statements).

#### **A. Claims 1 and 11**

Claims 1 and 11 have been amended to include the subject matter of claims 2 and 6. Former claim 6 recites that the auxiliary roller is arranged such that it contacts a center of one surface of a sheet of paper in the widthwise direction.

The Examiner maintains that the unlabeled roller, which corresponds to roller 6, in Fig. 3 of Hashida, discloses the claimed auxiliary roller. However, as shown in Fig. 3, the arm 18 appears to be arranged in the center of the widthwise direction of the paper stack L. Since the roller 6 and the unlabeled roller (i.e., alleged auxiliary roller) are positioned to respective sides of the arm 18, they cannot also be positioned or arranged in the “center.”

The Examiner further refers to Fig. 1 of Choeng as disclosing an auxiliary roller in the center of a widthwise direction of a sheet of paper. Applicant assumes that the Examiner is referring to the unlabeled roller positioned between the two rollers 24. However, such roller is neither labeled nor discussed in the teachings of the reference. Further, by merely looking at Fig. 1, it appears that such roller is disposed closer to the roller 24 shown on the right-hand side of the figure. Thus, the unlabeled roller would not be positioned in the “center.”

Consequently, claims 1 and 11 and their dependent claims should be deemed allowable.

**B. Claims 8-10, 12, and 13**

Since claims 8-10, 12 and 13 contain features that are analogous to the features recited in claim 1, Applicant submits that the claims should be deemed allowable for at least the same reasons.

**IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

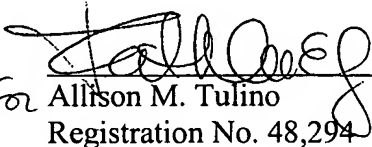
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Date: April 21, 2005